

## **REMARKS**

In the Office Action the Examiner noted that claims 1, 2 and 4-28 are pending in the application and the Examiner rejected all claims. By this Amendment, various claims have been amended. Thus, claims 1, 2 and 4-28 are pending in the application. The Examiner's rejections are traversed below.

### **Rejection Under 35 U.S.C. §112**

In the Office Action claims 1, 11 and 21-28 remain rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

In the Office Action the Examiner has withdrawn some of the previous rejections under 35 U.S.C. § 112. However, the Examiner still maintains the rejection with respect to the language "error is within a predetermined range." Claims 1, 11 and 21-28 have been amended to change the language "within a predetermined range" to --less than a predetermined value--. Thus, claim 1, for example, now recites that electronic mail is transmitted "only when an error, between the image information and prestoring image information, is less than a predetermined value."

It is submitted that this new language is fully supported by pages 15 and 16 of the specification, while accommodating the Examiner's objection to the term "range". Therefore, it is submitted that claims 1, 11, and 21-28, as amended, meet the requirements of 35 U.S.C. § 112.

The Examiner makes certain comments regarding the other prior 112 rejections in items 6, 7 and 8 of the Office Action but essentially now specifies that reference should be made to the new rejections which are specified in items 18 and 19 on pages 6 and 7 of the Office Action. Item 18 relates to the issue of the term "error" and is discussed above, while item 19 is a rejection for the omission of essential steps.

The Examiner references M.P.E.P. §2117.01 entitled "Unclaimed Essential Matter". This portion of the M.P.E.P. specifies that a claims which fails to interrelate essential elements of the invention may be rejected under 35 U.S.C. § 112, second paragraph. In particular, the Examiner indicates that the formation of the electronic signature file is missing from claim 1. However, claim 1 is directed to a situation in which the electronic signature file is already in existence. Therefore, it is submitted that it is unnecessary to specifically recite a step of forming an electronic signature file.

In summary, it is submitted, that the claims, as amended, meet the requirements of 35 U.S.C. § 112.

#### Rejection Under 35 U.S.C. § 103

In items 20-48 on pages 7-13 of the Office Action, all claims are rejected under 35 U.S.C. 103(a) as being obvious in view of various combinations of U.S. Patent No. 6,332,193 to Glass et al. ("Glass"), U.S. Patent 6,019,761 to Uomini ("Uomini") and U.S. Patent 5,999,967 to Sundsted ("Sundsted").

#### The Prior Response

In response to the prior Office Action, the applicant made the following arguments in traversing the Examiner's prior art rejections.

1. Nothing in Glass indicates that biometric identification is included in an electronic mail.
2. Nothing in Glass suggest that the separate imaging system "transmits the electronic mail only when an error, between the image information and prestored image information, is within a predetermined range."
3. Glass limits its description to indicating that images remain valid for some predetermined time period but does not describe that the electronic mail would be transmitted only when an error is within a predetermined range as recited in prior claim 1.
4. Nowhere in Glass is there any suggestion or motivation that the purpose is to secure access to various types of "secured resources".
5. The applicant disputed the Examiner's use of Office Notice in rejecting the claims.
6. The applicant urged that Uomini does not teach or suggest "wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is within a predetermined range."
7. The applicant urged that the Examiner did not provide any evidence as to why one of skill would have been lead to combine the teachings of the references in the manner suggested by the Examiner.

### The Examiner's Response in the Current Office Action

In items 21-33 on pages 8-11 of the Office Action the Examiner has maintained the previous rejections. In items 10-14 on pages 3-6 of the Office Action, the Examiner purports to respond to the above arguments.

Referring to arguments 1-3 above, in item 10, the Examiner takes the position that Glass shows an image which is transmitted to a matcher which compares the converted image to those located in a template, storing an event, and is triggered only if the image is matched. However, the portion of Glass relied on by the Examiner (column 9, lines 50-60) does not teach or suggest the concept of determining whether the differences between the image and the prestored image are within a predetermined range. It only describes the concept of determining if the image is matched. Therefore, referring to the current claim language as set forth, for example in claim 1, applicant submits that the prior art does not teach or suggest "wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is less than a predetermined value. Therefore, it is submitted that claims 1, 11 and 21, 28 patentably distinguish over the prior art.

With respect to argument 5 above, the Examiner maintains the position that the Examiner is "entitled to take official notice that e-mails of restricted resource to which the biometric method of glass may be considered as applicable."

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

The Applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion.

With respect to argument 6 above, in item 12 on pages 4 and 5 of the Office Action, the Examiner takes the position that Uomini and Sundsted teach methods of secure e-mail in which the sender's identify information is studied.

Uomini generally describes a method of acquiring sender information of an electronic mail from a database or the like which stores the sender information separately from the message. However, similarly to Glass, Uomini is silent as to teaching or suggesting, "wherein

said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is less than a predetermined value,” as recited in independent claim 1. Uomini provides that it is useful to find context information in legacy messages and messages where the sender has taken no action to supply context information. If the sender does not provide a key field, the "From:" and "Organization:" header fields can be used.

Uomini and Glass fail to broach the concept of transmitting “the electronic mail **only** when an error, between the image information and prestored image information, is less than a predetermined value,” emphasis added, as recited in independent claim 1.

With respect to argument 7 above, the Examiner takes the position that the Examiner’s line of reasoning for combining the teachings of the prior art is valid. However, applicants submit that the Examiner’s explanation is based on improper hindsight.

According to the Office Action, “one of ordinary skill in the art would have combined the two inventions in order to better develop a digital signature that would be harder to manipulate,” and refers to Glass column 7, line 65, to column 8, line 13. However, the referenced portion merely describes generating unique values that would function as keys for a digital signature algorithm rather than just generating unique blocks of data. Contrary to the assertions made in the Office Action, nothing in the referenced portion of Glass teaches or suggests a need of providing an “electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail,” as recited in independent claim 1. Glass does not even mention electronic mail and merely relates to a technique for transferring the biometric information to the authentication apparatus.

MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.”

MPEP § 2142 states that “[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” Dembiczak, 50 USPQ2d at 1617. “The

factual inquiry whether to combine the references must be thorough and searching.” In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Glass would have been combined with Uomini. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner’s sole support for such a combination is that “in order to better develop a digital signature that would be harder to manipulate.” (Office Action, p. 6). The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in any of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Therefore, the Applicant respectfully submits that the rejections under section 103(a) are insufficient because the examiner has not presented a *prima facie* case of obviousness. The Applicant respectfully requests that the examiner withdraw the rejections.

Because independent claims 11, 23, 24, 26, and 27 include similar claim recitations as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 23, 24, 26, and 27, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 23, 24, 26, and 27.

Sundsted generally provides allowing a receiver of electronic mail to make a decision to accept, reject, prioritize, or expedite delivery of a piece of electronic mail based on the value of an attached electronic stamp. A sender side type attaches the electronic stamp and a receiver side part removes the electronic stamp and filtering the electronic mail based on the value of the electronic stamp. Thus, the determination used in the apparatus described in Sundsted is based on the evaluation of the electronic stamp, not based on “only when an error, between the image information and prestored image information, is less than a predetermined value,” emphasis added, as recited in independent claim 1.

Thus, even assuming, *arguendo*, that Glass, Uomini, and Sundsted were combined; a combination thereof would fail to teach or suggest all the recitations of independent claim 1. In particular, the combination of the cited references would be silent as to teaching or suggesting, "wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is less than a predetermined value," as recited in independent claim 1.

In addition, the motivation to combine Glass, Uomini, and Sundsted is provided in the Office Action as "one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance." However, the Office Action fails to provide evidentiary support in Glass and Uomini as needing the system of Sundsted where the receiver can trust the sender's evaluation of the importance of the electronic mail. Glass does not even mention electronic mail and merely relates to a technique for transferring the biometric information to the authentication apparatus. Uomini, in turn, merely provides that it is useful to find context information in legacy messages and messages where the sender has taken no action to supply context information. However, neither Glass nor Uomini suggest a need to assisting the receiver in determining the mail's importance of Sundsted.

The authorities previously set forth supporting improper motivation provided in the Office Action are incorporated herein.

Because independent claims 11, 21, 22, 25, and 28 include similar claim recitations as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 21, 22, 25, and 28, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 21, 22, 25, and 28.

### Conclusion

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

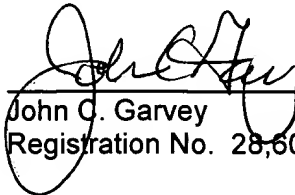
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner's contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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